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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/664,096	09/19/2000	Shigeaki Suzuki	0054-0222P	5277

7590 06/21/2004

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EXAMINER

WAHBA, ANDREW W

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 06/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/664,096

Applicant(s)

SUZUKI ET AL.

Examiner

Andrew W Wahba

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>3</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The co-pending application 09/827,915 has not been considered. As explained in MPEP 724, one submitting materials to the Office in relation to a pending patent application must generally assume that such materials will be made of record in the file and be made public. The applicant, however, does not waive confidentiality concerning the copending application.

Specification

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The applicant abstract is objected to as it reads like a claim, especially lines 10-16.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to preamble of claims 1, 4 and 5, the applicant should clarify lines 3-6. The manner in which a trunk channel is "repeated" is not understood. Use of only the term "connected" will overcome this portion of the rejection. Also, the phrases "with respect to" and "thereto via" (lines 3 and 4) make the claims difficult to follow. Regarding the phrase "not performing", the applicant should claim steps that are performed, and not those that are not performed (line 4).

In claim 1, the applicant claims "transmitting the number of trunk channel" (line 8). From this phrase it is not clear whether the applicant is literally transmitting the number of channels or rather transmitting a number of channels.

In claims 2 and 3, the applicant refers to the "number of said trunk channel" (lines 3-4) as well as the trunk channel number (line 6). It is not understood whether these two phrases are intended to be equivalent.

In claim 4, the applicant claims "outputted with respect to a trunk channel operation under pass-through operation" (lines 9-10). It is not clear whether the output is in response to ("with respect to") a trunk channel operation. Also, the meaning of the "trunk channel operation" is unclear.

In claim 4, the applicant claims "means for outputting a silent (silent) PCM signal" (line 24). The meaning of the term "silent" is unclear. Applicant should delete the second occurrence of term "silent".

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In claim 5, the meaning of the term "silent" as it refers to a PCM signal is unclear (line 16).

In claims 11 and 13, "a ADPCM system as defined in the ITU-T recommendation G.726" is claimed (lines 3 and 4). A description of this recommendation document and the limitations that it imposes does not appear to be included in the specification. Recommendations G.728/G.729 are described on page 87, lines 7-12.

Applicant is advised to ensure that dependent claims comply with 35 U.S.C. 112, second paragraph.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Handig (5,857,009). With regard to claim 1, Handig discloses a first digital circuit multiplication equipment (DCME) that for compressing digital information as illustrated by Fig. 2. DCME_A (digital circuit multiplication equipment) receives a plurality of inputs (number of trunk channel) from a first central office, Exchange A. DCME_A is connected (transmitting/notifying) to DCME_B (another digital circuit multiplication equipment) (column 6, lines 4-10). Handig distinguishes the

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information type when providing a particular bearer service (bearer circuit). Calls processed through a SS7 supported network have a dedicated (assigning) PCM time slot (column 6, lines 55-59).

Allowable Subject Matter

5. Claims 2 and 3 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 4-14 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew W Wahba whose telephone number is (703) 305-4684. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas W Olms can be reached on (703) 305-4703. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

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Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Andrew Wahba



June 8, 2004



CHAU NGUYEN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600